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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,174	08/29/2000	Robert A. Cordery	F-189	9744

7590

07/22/2002

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EXAMINER

HAYES, JOHN W

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 07/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/650,174

Applicant(s)

CORDERY ET AL.

Examiner

John W Hayes

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)).

Information Disclosure Statement

2. The information disclosure statement filed 29 August 2000, paper no. 3, fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It is noted that the U.S. and foreign patent references cited therein have been considered by the Examiner, however, the non-patent literature cited therein has not been considered since a copy of each of the references was not provided and was not available to the Examiner.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer, U.S. Patent No. 4,868,877 in view of Musgrave, U.S. Patent No. 6,105,010.

As per **Claim 35**, Fischer discloses a method for validating a signed digital message, comprising the steps of receiving a signed digital message from a sender and validating the signed digital message using a public key of the sender (Col. 3, lines 22-35; Col. 6, lines 34-45; Col. 7, lines 5-30 and 60-67). Fischer, however, fails to explicitly disclose providing a register having funds stored therein, determining if sufficient funds are present in the register for validating the message and deducting funds from the register for validating the message. Musgrave discloses a method for receiving a digital message in the form of a transaction request along with a biometric certificate and uses this information to validate the electronic transaction. Musgrave also teaches that in conjunction with validating the transaction, the certifying authority processor accesses a billing rate database for generating a bill or charge for the process of verifying and/or providing a report on the confidence of the authentication and further teaches that the charge may be in the form of a credit card transaction which has been pre-authorized as a means to guarantee payment for the service. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Fischer and include determining if sufficient funds are available for processing the validation and charging the consumer or deducting funds. The motivation would be to guarantee payment to the certificate authority for validating the transaction.

As per **Claim 36**, Fischer further discloses receiving with the signed digital message a certificate of the sender, the certificate being signed using a private key of the certificate authority (Col. 3, lines 21-34, Col. 7, lines 5-29 and 60-67), validating the certificate using a public key of the certificate authority (Col. 7, lines 30-67), and extracting the public key of the sender from the certificate for use in validating the signed digital message (Col. 3, lines 21-34; Col. 6, lines 34-43; Col. 7, lines 5-30) which is a process well known in the encryption and digital signature arts.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982);

Art Unit: 3621

In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 35 and 36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 5,796,841 in view of Fischer, U.S. Patent No. 4,868,877.

As per **Claims 35-36**, Claim 2 of U.S. Patent No. 5,796,841 recites:

- a register having funds stored therein
- adjusting debit funds stored in the register when a cryptographic certificate is processed

Claim 2 of U.S. Patent No. 5,796,841 differs since it fails to specifically recite receiving a signed digital message from a sender and validating the signed digital message using a public key of the sender. Claim 2 further fails to disclose receiving with the signed digital message a certificate of the sender, the certificate being signed using a private key of a certificate authority, validating the certificate using a public key of the certificate authority and extracting the public key of the sender from the certificate for use in validating the signed digital message, however, these features are taught by Fischer (Col. 3, lines 21-34, Col. 7, lines 5-29 and 60-67; Col. 6, lines 34-43; Col. 7, lines 5-67). Fischer further discloses receiving a signed digital message from a sender and validating the signed digital message using a public key of the sender (Col. 3, lines 22-35; Col. 6, lines 34-45; Col. 7, lines 5-30 and 60-67) which is a process well known in the encryption arts. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify claim 2 of U.S. Patent No. 5,796,841 and include the features taught by Fischer. Validating digital messages using a public key of the sender by extracting the public key from a certificate is a well known practice in the encryption arts and it would have been obvious to include these features in claim 2 of U.S. Patent No. 5,796,841 for information security reasons. Fischer indicates that

Art Unit: 3621

cryptographic systems are widely used to insure the privacy and authenticity of messages communicated over insecure channels (Col. 1, lines 20-25).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Weiant, Jr. et al disclose a certificate meter and an accounting register wherein digital signatures are attached to a message and wherein there is an accounting for a service charge associated with each use of the certificate meter and to ensure that upon receipt of a message the recipient can verify that the message is genuine and signed by the sender and the message has not been altered.
- Lee et al disclose a method for using a smart card to gain access upon payment of a value and teach authenticating the existence of funds to pay for a transaction.

Art Unit: 3621

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

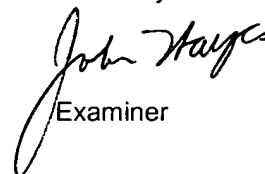
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

The Fax phone number for the **UNOFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 746-5531 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

The Fax phone number for the **OFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 305-7687 (for formal communications intended for entry including After-Final communications).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

John Hayes



Examiner

18 July 2002